

## **REMARKS**

### **Introduction**

Claims 14-21 and 23-26 are currently pending in this application after cancellation of claim 22 in this Amendment. Claims 14 and 24 have been amended to include the subject matter previously recited in claim 22.

Applicants thank the Examiner for the acknowledgement of foreign priority under 35 U.S.C. §119 and the indication that all certified copies of the priority documents have been received.

### **Rejection of Claims 14 and 24 under 35 U.S.C. §102(b)**

Claims 14 and 24 were rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 6,424,157 to Gollomp et al. ("Gollomp").

To reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. *See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the anticipation rejection is premised on the doctrine of inherent disclosure, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flow from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Amended claim 14 recites, in relevant parts, “a third device that determines an electrical battery variable in which a characteristics map of the electrical battery variable is stored as a function of the state of charge of the vehicle battery, a value of the electrical battery variable, which is present after the predefined time period, being read out from the characteristics map; a measurement device configured to measure an electrical variable of the vehicle battery during a starting operation, wherein the measured electrical variable is used to correct the stored characteristics map.” Amended claim 24 recites substantially similar features as the above-recited features of claim 14. To the extent the Examiner cites column 8, lines 35-60 and column 14 of Gollomp as allegedly disclosing the claimed features of claim 14, Applicants note that nothing in Gollomp teaches or suggests the claimed feature of “a measurement device configured to measure an electrical variable of the vehicle battery during a starting operation, wherein the measured electrical variable is used to correct the stored characteristics map.” Gollomp merely discloses computing the battery time before the vehicle start by using a characteristic curve corresponding to maximum starting current vs. ambient temperature, which curve is pre-programmed in the form of a lookup table, but nothing in Gollomp discloses or suggests the feature that a measured electrical variable of the vehicle battery measured during starting operation is used to correct the stored characteristics map.

For at least these reasons, claims 14 and 24 are not anticipated by Gollomp.

**Rejection of Claims 15-23, 25 and 26 under 35 U.S.C. §103(a)**

Claims 15-23, 25 and 26 were rejected under 35 U.S.C. §103(a) as unpatentable over Gollomp. Claim 22 has been canceled.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have

prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Pending claims 15-21, 23, 25 and 26 depend from independent claim 14 or independent claim 24. In support of the rejection, the Examiner contends that it would have been obvious “to have substituted the table of variables with the claimed map characteristic since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.” (Office Action, p. 3-4). However, as discussed above in connection with claims 14 and 24, Gollomp clearly fails to teach or suggest the claimed structural limitations of “**a measurement device configured to measure an electrical variable of the vehicle battery during a starting operation, wherein the measured electrical variable is used to correct the stored characteristics map.**” Accordingly, the Examiner’s asserted “intended use” argument simply cannot support the obviousness rejection of claims 15-21, 23, 25 and 26 which depend from independent claim 14 or independent claim 24.

Accordingly, for at least the foregoing reasons, Applicants submit that claims 15-21, 23, 25 and 26 are allowable over Gollomp.

**CONCLUSION**

In light of the foregoing, Applicant respectfully submits that pending claims 14-21 and 23-26 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,  
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